

REMARKS

This communication is considered fully responsive to the Office action mailed November 11, 2004. An amendment was submitted previously that canceled claims 1-9 and added new claims 10-21. Claims 10-21 were presently examined and stand rejected. Claims 10, 13, 16 and 21 have been amended. New claims 22-23 have been added. No new matter has been added by the amendments or claim additions.

FILING OF NOTICE OF APPEAL

A Notice of Appeal was filed on February 7, 2005 to prevent the case from going abandoned prior to a response that was due no later than February 11, 2005, and also prior to an Examiner Interview that took place on February 9, 2005. The February 9th interview was originally scheduled for February 2, 2005, but was rescheduled at the Examiner's request. The Applicants were in position to submit an amendment and response at an earlier time, particularly on February 2, 2005, and in any case prior to the filing of the Notice of Appeal. However, the Applicants were waiting for the February 9th interview, since the Applicants were confident that the parties would reach an agreement on allowable subject matter. Tentative agreement was reached on subject matter that appears to be allowable during the February 9th interview. Therefore, since the Applicant has shown a good and sufficient reason why the amendment is necessary and was not earlier presented, the requirement of 37 C.F.R. §1.116(a)(3) is satisfied.

In light of the conversation between the Examiner and the Applicants' representatives on February 9, 2005, the Applicant submits this amendment after final to place this case in condition for allowance. Under 37 C.F.R. §41.33, 37 C.F.R. §1.116 and MPEP §§1207 and 1210, this amendment after final may be entered since the requirements of 37 C.F.R. §1.116 are satisfied and jurisdiction has not yet passed to the Board of Appeals.

SUMMARY OF EXAMINER INTERVIEW

Attorneys Thomas J. Rossa and Ronald C. Gorsché participated in a telephone interview with Examiner Handy and Examiner Warden on Wednesday, February 8, 2005 at 11:00 a.m. MST. The parties discussed the design of the Applicants' system/method with counsel suggesting that it was an elegant solution for transferring the tips. While all understood that the system and method were unique, it was also noted that claiming such a system/method is difficult.

The parties discussed the differences from the prior art and also discussed a proposed claim amendment adding "consisting of" to the independent claims. Finally, the parties discussed how the proposed claim language avoids the §112 rejections and where there was support in the parent provisional application for the claimed features.

IN THE CLAIMS

Claims 10-21 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement by containing subject matter which is not described in the specification (See ¶2 of the Final Office Action dated 8/11/04). Claims 10-20 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite (See ¶4 of the Final Office Action dated 8/11/04). Applicant has made certain amendments to claims 10, 13, 16 and 21 in order to place all pending claims in this case in condition for allowance. Further, Applicant has provided argument below to support the case for allowance. Applicant respectfully requests that all pending claims be allowed.

A. Rejection under 35 U.S.C. § 112, first paragraph, is unfounded and should be withdrawn

Claims 10-21 stand rejected under 35 U.S.C. § 112, paragraph 1 as failing to comply with the written description requirement. Applicant respectfully traverses the rejection in its entirety.

In particular, independent claims 10, 16 and 21 have been rejected based upon certain amendments to the claims in the November 21, 2003 response. The previous response added three particular claim limitations, stated in various ways in each independent claim, that the Final Office action rejects under 35 U.S.C. §112, first paragraph.

In particular, claim 10 was amended to add three specific limitations that form the basis for the §112, first paragraph rejection. The first limitation recites “a stack of receiving plates unconnected to and unconnectable to any other structure.” The second limitation recites a “stack of receiving plates . . . having only a plurality of apertures formed therein each sized to receive a pipette tip therethrough.” The third limitation recites a “transfer member configured to not be connectable to any receiving plate of said stack of receiving plates.” Applicants will address the §112, first paragraph rejection for each claim limitation in separately titled sections hereunder.

Independent claims 10, 16 and 21 incorporate some or all of the three limitations listed above, in some shape or form. Since independent claim 10 incorporates all three limitations, claim 10 will be addressed at the outset. The arguments provided for claim 10 will also apply to similar limitations contained within independent claims 16 and 21. Any differences will be addressed separately thereafter.

1. **The previous amendment to independent claim 10 adding a limitation to recite that the claimed stack of receiving plates has “only a plurality of apertures formed therein each sized to receive a pipette tip therethrough” is not new matter.**

Applicant respectfully traverses the 35 U.S.C. §112, paragraph 1 rejection of claim 10 based on the addition of new matter - i.e. the addition by amendment to claim 10 of the limitation “having only a plurality of apertures formed therein each sized to receive a pipette tip therethrough.” Notwithstanding the traverse by Applicant, Applicant amends claim 10 to remove the claim limitation “having only” and replaced it with the limitation “consisting of.”

The closed-ended transition term “consisting of” conveys what the Applicant intended with the amended phrase “having only.” That is, the receiving plates have a plurality of apertures formed in each one. Each aperture is sized to receive a pipette tip therethrough and to support the pipette tip. The receiving plates have **no other structure or element formed therein.**

“[I]nformation contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter.” See MPEP §2163.06. Because the specification and drawings of the application as filed support the amendment introducing the limitation “having only a plurality of apertures formed therein each sized to receive a pipette tip therethrough,” Applicant asserts that no new matter is involved, and the rejection asserting the addition of new matter by amendment is groundless.

Applicant directs attention to discussions within the specification supporting a stacking plate having only a plurality of apertures for pipettes. For example, FIG. 1 shows a receiving plate 20 having a plurality of openings 22. See Application as filed, FIG. 1. Consistent with FIG. 1, in the specification, the Applicant discusses that each receiving plate 20 includes a rectangular array of ninety-six (96) openings 22 for receiving pipette tips 26, which is also illustrated in FIG. 2. See Application as filed, page 6, lines 13-15 and FIG. 2. Moreover, the Applicant also illustrates a holder tray 78 which is typically configured to hold 96 pipette tips. See Application as filed, lines 25-26.

In support of the §112, paragraph 1 rejection, the Office Action refers to a portion of Applicants’ specification where it is stated that “it is understood that receiving plate 20 can include any number of openings 22.” One skilled in the art would recognize, based upon the foregoing discussion, that the recitation of “any number of openings 22” does not mean anything

less than a plurality. Rather, any number of openings means that the user could vary from 96 apertures up or down a few to meet or match with the openings of a holder tray. Such recognition would follow from, among other things, (i) the Applicants' Brief Summary of the Invention (See Application as filed, page 3, lines 20-24, lines 26-28); (ii) the detailed description of the preferred embodiment (See Application as filed, page 6, lines 13-15, lines 16-17; page 8, lines 5-16; page 9, lines 24-26); (iii) the information conveyed in FIGS. 1, 2, 4, 7 and 8; and (iv) the positive recitation in the originally filed claim 1 of a stacking plate having nothing less than a plurality of apertures (See Application as filed, independent claim 1, "a receiving plate having a plurality of apertures sized for and having pipettes positioned therethrough"). Indeed, one skilled in the art would recognize that the invention would not be applicable to an array with one or two apertures and one or two pipette tips.

In summary, nowhere in the specification, claims or drawings as filed does Applicant disclose receiving plates having anything but an array of apertures disposed therein which constitute any number of openings in and X-Y array or pattern as shown. Accordingly, the Applicants respectfully disagree with the contention that the addition of the limitation "only a plurality of apertures formed therein each sized to receive a pipette tip therethrough" to claim 10 constitutes new matter. Applicant requests reconsideration of the rejection.

Since the limitation "having only" is supported by the original specification, claims and figures, amended claim 10 adding the limitation "consisting of" is supported as well. Because claim 10 as amended is clearly supported by the specification, the rejection under 35 U.S.C. §112, paragraph 1 should be withdrawn.

2. **The previous amendment to independent claim 10 adding a limitation to recite that the claimed stack of receiving plates is “unconnected to and unconnectable to any other structure” is not new matter.**

Applicant respectfully traverses the 35 U.S.C. §112 rejection of claim 10 based on the addition of new matter - i.e. the addition by amendment to claim 10 of the limitation “a stack of receiving plates unconnected to and unconnectable to any other structure” (emphasis added to show the amended limitation). Notwithstanding the traverse by Applicant, Applicant amends claim 10 to remove the claim limitation “any other structure” and replace it with the limitation “a transfer member.” The currently amended phrase “a stack of receiving plates unconnected to and unconnectable to a transfer member” conveys what the Applicant intended with the phrase “a stack of receiving plates unconnected to and unconnectable to any other structure.” That is, the receiving plates are not connected to and cannot be connected to any other structure. This is stated in claim 1 of the parent provisional on page 11.

Based upon the original specification, the receiving plate must be unconnected to any other structure (e.g. the transfer member) for the described method to operate. The two elements are necessarily unconnected, because the receiving plate and transfer member have to be firmly grasped between the thumb and the forefinger to lift the two elements up and away from the stack of plates. After transfer, the user releases his/her firm grasp on the receiving plate, the transfer member can be lifted up and away because the projections of the transfer member are easily removed from the top openings of the pipettes in the apertures of the receiving plate. See Page 10, lines 5-20. If there was a connection between the receiving plate and any other structure, this operation would not be possible.

Further, the original specification at page 3, line 8, points out that the prior art has a locking mechanism and identifies a need for a “simple and easy” way to “transfer . . . pipette tips from a storage container to a holding tray **without requiring latching mechanisms or other**

moving parts.” Page 3, lines 14-16 (emphasis added) At page 11, line 9-10, the claim as filed defines the system and recites that the transfer member “has an under surface spaced from and **not connected** to said receiving plate . . .” (Emphasis added) In accord are FIGS. 1-4, 7-10;

It must follow that one skilled in the art would recognize that the receiving plates are clearly unconnected and unconnectable to any structure, including the transfer plate. The plate and transfer member are held in alignment by a user’s thumb and forefinger, and are in no way connected or connectable. Because claim 10 as amended is clearly supported by the specification, the rejection under 35 U.S.C. §112, paragraph 1 should be withdrawn.

3. The previous amendment to independent claim 10 adding a limitation to recite that the claimed transfer member is “configured to not be connectable to any receiving plate of said stack of receiving plates” is not new matter.

Applicant respectfully traverses the 35 U.S.C. §112 rejection of claim 10 based on the addition of new matter - i.e. the addition by amendment to claim 10 of the limitation a “transfer member configured to not be connectable to any receiving plate of said stack of receiving plates.” (emphasis added to show amended limitation). For similar reasons that the limitation “a stack of receiving plates unconnected to and unconnectable to any other structure” is not new matter (as described above), the non-connectibility aspect of the transfer member is also not new matter.

Applicant requests that the rejection of claim 10 under 35 U.S.C. §112, paragraph 1 be withdrawn.

4. Independent claims 16 and 21 contain amendments similar to independent claim 10 and are therefore not new matter for the same reasons.

Claim 16 recites the limitations “said receiving card consisting of a matrix of card apertures formed therein” and “said transfer member being configured with no structure for attaching said transfer member to said receiving card.” (emphasis added). Claim 21 recites the

limitations “a receiving card consisting of a matrix of card apertures formed therein” and “said transfer member being without structure for connecting said transfer member to said receiving card.” (emphasis added). For the reasons discussed above with respect to the comparable limitations recited in claim 10, the amended claim limitations of claims 16 and 21 are clearly supported by the specification and do not comprise new matter. Applicant requests that the rejection under 35 U.S.C. §112, paragraph 1 be withdrawn for claims 16 and 21.

B. Rejection under 35 U.S.C. § 112, second paragraph, is unfounded and should be withdrawn

Applicant respectfully traverses the Examiner’s rejection of claims 10-20 for failure to particularly point out and distinctly claim the subject matter which Applicant regards as his invention - i.e. that the recitation in claim 10 that the receiving plates are “unconnected to and unconnectable to any other structure.” Notwithstanding the traverse by Applicant, Applicant has amended claim 10 to remove the claim limitation “any other structure” and replaced it with the limitation “a transfer member.” The currently amended phrase “a stack of receiving plates unconnected to and unconnectable to a transfer member” conveys what the Applicant intended with the phrase “a stack of receiving plates unconnected to and unconnectable to any other structure,” namely, that the receiving plates are not connected to and cannot be connected to any other structure, specifically, a transfer member that maintains pipette tips in a substantially vertical orientation with respect to a receiving plate.

The focus of rejecting claims 10-20 is that the reference to “unconnected to and unconnectable to” is indefinite. In response, Applicant respectfully asserts that the rejection is not focusing on the claim language in light of the teachings of the prior art and of the disclosure contained in the Applicants’ specification. In other words, when the claim language referencing “unconnected to and unconnectable to” is viewed in light of Applicants’ specification, drawings,

and claims in light of the prior art (e.g. U.S. Patent No. 5,324,482 to Scaramella et al.), the claims circumscribe the boundaries of the claimed subject matter with the requisite degree of precision and particularity.

Claim 16 recites the limitations “a receiving card unconnected to and configured to not be attachable to any structure configured for engaging and maintaining said pipette tips in a stable position relative to said receiving card” and “said receiving card consisting of a matrix of card apertures formed therein.” Claim 16 was amended to specify the structure of the receiving card. For the reasons discussed above with respect to the comparable limitations recited in claim 10, the amended claim limitation of claims 16 clearly particularly points out and distinctly claims the subject matter which Applicant regards as his invention.

Therefore, Applicant respectfully requests that the rejection be withdrawn for claims 10-20.

NEW CLAIMS 23-24

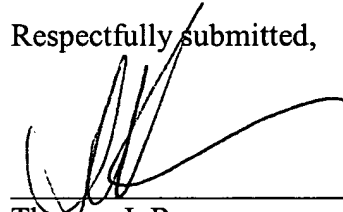
Applicant has added new claims 23-24 that substantially track the language of independent method claim 10 and independent system claim 16. However, instead of utilizing the term “consisting of,” the Applicant has used the term “consisting essentially of” to more accurately describe the claimed receiving plate of the present invention. The transitional phrase “consisting essentially of” limits the scope of a claim to the specified materials or steps “and those that do not materially affect the basic and novel characteristic(s)” of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976) (emphasis in original). From the Applicants’ perspective, the addition of “consisting essentially of” to claims 22 and 23 instead of “consisting of” has in effect the same scope in coverage. However, the addition of the transitional phrase “consisting essentially of” does prevent nonessential modifications to a potentially infringing device that do not affect the novel characteristics of the claimed invention.

CONCLUSION

The rejection of claims 10-21 is deemed avoided. In turn, all claims should be allowable. Early action and allowance is respectfully requested for all pending claims. If there are questions, the Examiner can reach applicants' counsel at (801) 521-5800 or by e-mail at Thom.Rossa@HRO.com.

Please charge any fees not accompanying this communication that may be required to deposit account 08-2665.

Respectfully submitted,



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